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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,462	06/09/2000	Tracy E. Grim	480032-307	4478

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EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,462

Applicant(s)

GRIM ET AL.

Examiner

Marie Patterson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 33-50, 53-58, 67 and 69-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23, 33-49, 53, 57, 67 and 69-85 is/are allowed.
- 6) ☒ Claim(s) 50, 54-56, and 58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Reissue Applications

1. Claims 50, 54-56, and 58 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 50, 54-56, and 58 do not contain the limitations "an inner sole extending substantially over the entire sole area" and "said grid of resilient sections comprising substantially all of said inner sole and extending over substantially all of said sole area" which were added and argued in the amendment filed 6/17/96 which resulted in the Examiner allowing claim 17, now patented claim 19 which is the broadest claim in the original patent. Therefore, applicant has previously surrendered the subject matter of an inner sole which does not extend substantially over the entire sole area with a grid of resilient sections which does not comprise substantially all of the inner sole and extends

over substantially the entire sole area. It is also noted that these limitations were argued by application for patentability in the amendment filed 6/17/96.

Note MPEP 1412.02 which states "The recapture rule bars the patentee from acquiring through reissue claims that are, in all aspects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent. Ball, 729 F.2d at 1436, 221 USPQ at 295." Canceled claim 20 of parent application 08/360798 recited "....an inner sole extending substantially over the entire sole area mounted in said footgear above said outer sole, said inner sole having a plurality of removable sections that are removably mounted in said footgear and that area arranged in a grid pattern, said removable sections having lower surfaces which are removably secured within said footgear and said sections together....said grid...comprising substantially all of said inner sole and extending substantially over the entire sole area.", therefore claims which do not require such are considered to be barred in a reissue application per MPEP 1412.02. Claims 50, 54-56, and 58 are considered to be broader or of the same scope as the canceled claim 20 in the prior application and therefore barred.

2. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

3. The reissue Declaration filed with this application is defective (see 37 CFR 1.175 and MPEP 1414) because of the following:

The original Declaration is not relevant to the newly filed claims.

4. It is noted that applicant has requested that the requirement for new Declarations be deferred until claim language is finalized and thus such a requirement is deferred and will be required when the claims are finalized.

Allowable Subject Matter

5. Claims 1-23, 33-49, 53, 57, 67, and 69-85 are allowed.

6. Claims 50, 54-56, and 58 would be allowable if rewritten or amended to overcome the recapture rejection set forth in this Office action.

Response to Arguments

7. Applicant's arguments filed 1/23/04 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the recapture rejection based on 35 USC 251, the added limitations to the claims, i.e. the height limitation or means for swaying limitations, are not related to the subject matter previously surrendered by applicant (as noted above in paragraph 1 above) and therefore recapture exists, even though the replacement limitation is a narrowing limitation. See *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165. In the prosecution of an application, a claim limitation which has been added and/or argued by applicant to make the claims allowable over an art rejection resulting in the claims being allowed, results in the subject matter omitting such a limitation being surrendered. In a later application requesting reissue of that patent, applicant cannot then omit or eliminate that limitation. Claim subject matter which omits that limitation has been surrendered in the prosecution of the original

application and applicant cannot then recapture that claim subject matter by way of reissue. See *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997). As applicant noted "If the broadening aspect of the reissue claim relates to subject matter previously surrendered, ... If the narrowing limitation modifies the claim in such a manner that the scope of the claim no longer results in a recapture of the surrendered subject matter...", this is not the case here, the narrowing limitation is not related to the surrendered subject matter and therefore recapture of the surrendered subject matter exists. And as applicant noted on page 24 "If the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim." The swaying limitation is completely unrelated to the surrendered limitation directed towards the extent of the inner sole in reference to the outer sole as noted above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9306. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.


Marie Patterson
Primary Examiner
Art Unit 3728